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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,355	03/30/2004	Joel C. Higgins	5490-000378	5019
27572 7590 06/08/2007 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			EXAMINER PHILOGENE, PEDRO	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 06/08/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/813,355

**Applicant(s)**

HIGGINS, JOEL C.

**Examiner**

Pedro Philogene

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burstein et al. (2005/0027365) in view of Salehi et al. (6,645,251).

With respect to claims 1, 19, 33, Burstein et al disclose a prosthetic implant comprising a femoral component operable to replace at least a portion of a patient's natural femur; as set forth in para [0077] a tibial component (302) operable replace at least a portion of a patient's natural tibia, the tibial component having a superior tibial component surface, as best seen in the FIGS.; and a bearing operable to provide engagement between the femoral component and the tibial component having a superior bearing surface (304) operable to articulate with the femoral component; and an inferior bearing surface operable to cooperate with the superior tibial component surface; as best seen in the FIGS.; a wear reduction device (310) located at at least one the superior tibial component surface and the inferior bearing surface operable to reduce wear upon at least one the superior tibial component surface and the inferior bearing surface. A tibial plate (302, a superior surface, an inferior surface opposite the superior surface a bearing engagement surface (106) located at the superior surface; and a wear reduction surface (310) located at the superior surface, a stem (306) extending from the inferior surface. A first member (304), a second member (302)

engaging the first member; and a wear reduction device (310) provided on at least one of the first member and the second member to reduce wear of the first member and the second member.

With respect to claims 2-8, 20-22,34-37,48, Burstein et al discloses all the limitations, as set forth in page 3, para [0069-0070], page 4, para[0074-0082], para [0084-0087], page 5, para[0088] para [0101-0105], page 6, para [0109], para [0122]; and as best seen in FIGS.1-20.

It is noted that Burstein et al did not teach of this preferred material to make the bearing, as claimed by applicant. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any known material to make the bearing, since it has been held to be within the general skill of the worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Furthermore, the use of these materials in the bearing field is old and well known in the art, as set forth in the pertinent art cited.

It is noted that Burstein et al did not teach of a wear reduction device coplanar with at least one of the superior tibial component surface and the inferior bearing surface; as claimed by applicant. However, in a similar art, Salehi et al evidence the use of a wear reduction surface on a tibial component that is coplanar with the tibial component to provide decreased wear area by providing textured areas that have certain configurations and shapes that have shown to be particularly effective at reducing overall wear rates.

Therefore, given the teaching of Salehi et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Burstein et al, as taught by Salehi et al. by providing a wear reduction surface on a tibial component that is coplanar with the tibial component to provide decreased wear area by providing textured areas that have certain configurations and shapes that have shown to be particularly effective at reducing overall wear rates.

***Response to Amendment***

Applicant's arguments, see Remarks, filed 3/16/07, with respect to the rejection(s) of claim(s) 1-48 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Salehi et al.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
June 3, 2007

  
PEDRO PHILOGENE  
PRIMARY EXAMINER